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No. 04-1350

IN THE

Supreme Court of the United States

KSR INTERNATIONAL CO.,
Petitioner,

v.

TELEFLEX INC. AND TECHNOLOGY HOLDING CO.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION OF THE PROGRESS & FREEDOM FOUNDATION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

AND

BRIEF OF THE PROGRESS & FREEDOM FOUNDATION AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

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MOTION OF THE PROGRESS & FREEDOM FOUNDATION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE* IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

The Progress & Freedom Foundation (PFF) respectfully moves this Court for leave to file the accompanying brief *amicus curiae* in support of the *Petition for a Writ of Certiorari* submitted by KSR International (KSR).

A letter of consent to the filing of this brief has been received from petitioner KSR. However, respondents Teleflex Inc. and Technology Holding Co. refused to grant consent, offering no explanation, and necessitating this motion.

The interest of PFF in this case stems from the work of our scholars on the interaction of technological change with the legal institution of intellectual property. We are strong supporters of intellectual property, and our scholars argue that strong and effective IP rights are vital to the effective functioning of free markets, and thus to the economic and social health of the nation and the world. In consequence, PFF has an interest in supporting the position of the petitioner when it urges this Court to restore vigor to the non-obviousness standard, thereby preventing the degradation of patent quality and a corresponding loss of credibility of the patent system itself.

Petitioner has briefed the technical aspects of this case concerning the prior art relating to the invention at issue, the serious split between the Federal Circuit and other circuits, and the Federal Circuit's disregard of this Court's patent precedents. PFF's proposed brief does not re-cover this ground. Rather, its analysis focuses on the importance of the policy issues presented by the case, and on the urgency of the need for this Court to address the stresses on the patent system created by economic and technological changes that

have occurred in the more than quarter of a century since the nonobviousness standard last commanded its attention.

For the above reasons, this motion for leave to file the attached brief *amicus curiae* should be granted.

Respectfully submitted,

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INTEREST OF *AMICUS CURIAE*

The Progress & Freedom Foundation (PFF) is a non-profit research and educational institution, as defined by the Code of the Internal Revenue Service, 26 U.S.C. § 501(c)(3).[1] The Foundation's principal mission is to study the impact of the

[1] Pursuant to Supreme Court Rule 37.6, *Amicus Curiae* states that no counsel for any party to this dispute authored this motion or this brief in whole or in part and no person or entity other than *Amicus Curiae* made a monetary contribution to the preparation or submission of this motion or this brief.

digital and electronic revolution and its implications for public policy.

PFF's interest in this case stems from the work of an internal project called IPCentral.Info (a.k.a., the Center for the Study of Digital Property (CSDP)), which is dedicated to developing and advancing market-based, property-rights-oriented approaches to issues presented by technological change. This focus makes us strong supporters of property rights in intellectual creations. For example, we filed a brief with this Court in support of the content industry petitioners in *Metro-Goldwyn-Mayer Studios v. Grokster, Ltd.*[2]

In furtherance of the mission, we maintain a website, *IPcentral.Info*,[3] which contains links to a variety of materials on intellectual property issues, including written materials, a weblog, and links to other sites with related interests. Staff members prepare or commission analyses of important intellectual property issues. Staff members also appear before congressional committees and interact regularly with journalists, academicians, industry representatives, and government officials.

PFF, precisely because of its fierce insistence on the importance of intellectual property rights and markets to the world economy, is concerned that the patent system not overreach by trying to protect too much. Extensions of the system to cover creations that are not true advances cause misallocation of resources and provide ammunition to those whose goal is to undermine the basic idea of patents.

Stemming from this concern, PFF is disturbed by the Federal Circuit's over-lenient application of the criterion that

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[2] *Brief of* Amicus Curiae *Progress and Freedom Foundation in Support of Petitioner*, Metro-Goldwyn-Mayer Studios v. Grokster, Ltd., *cert. granted*, __U.S.__ (2004) (Dkt. No. 04-480) (Brief filed: Jan. 24, 2005).

[3] http://www.ipcentral.info

an invention be nonobvious, and has a strong interest in urging this Court to reverse this trend.

SUMMARY OF ARGUMENT

We urge the Court to grant *certiorari* in this case because of the growing concern among patent scholars and business practitioners over the Federal Circuit's lax standard of "obviousness." Over a quarter of a century has passed since this Court last considered the application of this statutory standard. Meanwhile, technological change has transformed the economy and the importance of property rights in creativity has grown as intellectual capital replaces physical capital as the great engine of economic productivity.

The Federal Trade Commission, the National Research Council, and many scholars have expressed concern about the quality of patents, and link the problems in part to the Federal Circuit's interpretation of the "obviousness" standard. That court's insistence that patent examiners find in prior art some concrete suggestion or motivation for combining previous elements into the invention for which the patent is claimed poses an obstacle to patent examiners' ability to weed out trivial patents.

The standard of what is obvious or nonobvious to a person with "ordinary skill in the art" is a fulcrum of the quality issue. Too loose a standard discourages innovation by denying rewards to inventors. But too lax a standard triggers a gold rush after every significant advance, to improve on it in some trivial yet patentable way. The result is misdirected innovation. Immense transaction costs are imposed on the economy as businesses try to negotiate their way out of patent thickets.

There are better solutions to the problem of how to avoid the trap of hindsight in considering when a patent should be granted. The Federal Circuit's obviousness test establishes a one-way ratchet in favor of a patent grant. The resulting flood

of trivial patents retards innovation and competition. It also undermines the legitimacy of the patent system as a whole, as the system is perceived, particularly in other countries, to reward patentees at the expense of the public as a whole.

ARGUMENT

Petitioner lays out the compelling legal reasons for granting *certiorari* in this case: The Federal Circuit's steady, deliberate, and unwise departure from this Court's precedents; the conflict among the circuits; and the more than quarter of a century that has passed since this Court last considered the crucial concept of "nonobviousness."

Amicus will not repeat these points. Instead, it will focus on policy considerations that add gravitas to this matter.

I. The Growing Importance of Intellectual Property

On the surface, this case involves a simple product, the automobile accelerator pedal. But this product, like so many these days, has been revolutionized, because what was once a straightforward mechanical linkage is now a hybrid that marries the mechanical act of pressing a pedal to electronic devices composed mainly of computer chips and software code.

The pedal exemplifies the great shift in the nature of economic value that has occurred over the past few decades. As two prominent economic thinkers recently noted:

> We used to live in an economy in which the canonical source of value was an ingot of iron, a barrel of oil or a bushel of wheat. . . . We are moving to an economy in which the canonical source of value is a gene sequence, a line of computer code, or a logo. As Chairman Greenspan [citation omitted] has often emphasized, in such a world, goods are increasingly valued not for their

> physical mass or other physical properties but for weightless ideas . . . .[4]

The authors point out the change from the basic industrial economy:

> Back in the Gilded Age intellectual property as such was not such an important factor. Industrial success was based on knowledge, but on knowledge crystalized in dedicated capital. Many people knew organic chemistry. Few companies--those that had made massive investments—could make organic chemicals.[5]

This evolution in the locus of value increases the importance of setting proper definitions and boundaries on intellectual property. Thus, while the immediate case involves an accelerator pedal, it has long-term significance for software, biotechnology, pharmaceuticals, electronics, and the other paraphernalia of the digital age.

II. The Growing Unease About Patent Quality.

The level of concern about the quality of patents is high and rising, with particular focus on the "nonobvious" standard. A recent Federal Trade Commission (FTC) report devoted extensive attention to the issue of "questionable patents."[6] It recommended specifically that legal standards

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[4] J. Bradford DeLong & Lawrence H. Summers, *The New Economy: Background, Historical Perspective, Questions, and Speculations*, Federal Reserve Bank of Kansas City Economic Review 29, 35 (Fourth Quarter 2001) <http://www.kc.frb.org/PUBLICAT/ECONREV/Pdf/4q01delo.pdf > J. Bradford DeLong is Professor of Economics at the University of California at Berkeley; Lawrence H. Summers is the President of Harvard University.

[5] *Id.* at 51.

[6] Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition Law and Policy* (Oct. 2003), *passim*. <http://www.ftc.gov/os/2003/10/innovationrpt.pdf> [hereafter "FTC Report"].

used to evaluate whether a patent is "obvious" should be "tighten[ed]," and it criticized the test imposed on the field by the Federal Circuit.[7]

A study by the National Research Council (NRC) expressed similar fears:

> [Several factors] lead the committee to conclude that there are reasons to be concerned about both the courts' interpretation of the substantive patent standards, *particularly non-obviousness*, and the USPTO's application of the standards in examination. [Emphasis added.][8]

The Co-Chairs of this NRC study recently repeated this fear to a Senate subcommittee:

> The NRC committee supports seven steps to ensure the vitality and improve the functioning of the patent system:
>
> * * * *
>
> 2) Reinvigorate the nonobviousness standard. The requirement that to qualify for a patent an invention cannot be obvious to a person of ordinary skill in the art should be assiduously observed. In an area such as business

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[7] *Id.* at pp. 10-12. The FTC cited the statement of a witness who noted that "his company's engineers . . . 'every day' independently invent things that have been deemed nonobvious." The FTC added that "Requiring concrete suggestions or motivations beyond those actually needed by a person of ordinary skill in the art, and failing to give weight to suggestions implicit from the prior art as a whole, suggestions from the nature of the problem to be solved, and the ability and knowledge of one of ordinary skill in the art, errs on the side of issuing patents on obvious inventions and is likely to be unnecessarily detrimental to competition." Chapter 4 at p. 15.

[8] National Research Council, *A Patent System for the 21st Century* 62 (2004) (Stephen A. Merrill, Richard C. Levin, & Mark B. Myers (eds)) (Report of the Committee on Intellectual Property Rights in the Knowledge-Based Economy) <http://books.nap.edu/catalog/10976.html> [hereafter "NRC Report"].

> methods, where the common general knowledge of practitioners is not fully described in published literature likely to be consulted by patent examiners, another method of determining the state of knowledge needs to be employed.[9]

In reaching its conclusion, the NRC study relied on a rising tide of scholarly opinion:

> [A] number of legal scholars view the evolution of the law over the last generation as reducing the size of the step required for patentability under the non-obviousness standard and as allowing the issuance of patents on obvious inventions.[10]

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[9] Richard C. Levin (President, Yale Univ.) & Mark B. Myers (Wharton School, Univ. of Pennsylvania), Statement Before the Subcommittee on Intellectual Property, Senate Committee on the Judiciary, *Hearings on Perspectives on Patents*, April 25, 2005, <http://judiciary.senate.gov/testimony.cfm?id=1475&wit_id=4217>.

[10] NRC Report at 61. The works cited by this section of the report were (NRC citation form retained):

> Barton, J. (2003). "Non-obviousness." *IDEA: The Journal of Law and Technology* 43:475.
>
> Desmond, R. (1993). "Nothing Seems Obvious to the Court of Appeals for the Federal Circuit: The Federal Circuit, Unchecked by the Supreme Court, Transforms the Standard of Obviousness Under the Patent Law," *Loyola of Los Angeles Law Review* 26:455-490.
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>
> Vermont, S. (2001). "A New Way to Determine Obviousness: Applying the Pioneer Doctrine to 35 U.S.C. § 103(A)." *AILPA Quarterly Journal* 29(Summer):375-444.

Leading economics and business scholars concur:

> As a result of legal and administrative changes made between 1982 and 1990, the PTO has become so overtaxed, and its incentives have become so skewed toward granting patents, that the tests for novelty and non-obviousness that are supposed to ensure that the patent monopoly is granted only to true inventors have become largely non-operative. [11]

Surely, the attention and concern given this issue by so many prestigious and disinterested experts is a powerful indication that it should also command the attention of this Court.

III. The Standard Applied by the Federal Circuit Causes Harm

That the assessment of obviousness becomes contentious during a period of rapid technological change should not surprise. Human minds strike sparks from each other, and each innovation adds a new element for the creative to consider, and creates additional possible combinations with existing technologies. Such combinations are, by definition, novel. The question for patent law is whether such a combination is nonobvious, whether it is sufficiently beyond the routine competencies of practitioners in the field as to justify turning it into a property right.

In making this determination, two types of error are possible. One is that a patent will be denied that should have been granted; the other, that a patent is granted when anyone adequately skilled in the field, confronted with the problem solved by the novelty, would have come up with the same idea.

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[11] Adam B. Jaffe & Josh Lerner, *Innovation and Its Discontents: How Our Broken Patent System is Endangering Innovation and Progress, and What To Do About It* 34-35 (Princeton Univ. Press 2004).

Obviously (no pun intended), there is a gray area, where the outcome is not completely certain. It is fair to say that the Federal Circuit's test, which requires, in essence, documented and precise proof of "teaching-suggestion-motivation," defines the lower bound of that gray area. That is, any novelty that fails this test is obvious within the meaning of the patent law, beyond doubt, because prior practitioners already pointed it out.

However, some innovations might still be properly classified as obvious within the meaning of the statute even though prior writers have *not* pointed them out with precision, as this Court said repeatedly in its line of opinions starting with *Graham v. John Deere*[12] and ending with *Sakraida*.[13] The fact that the solution, in its exact form, had not been foreshadowed by prior writers may be indicative, but it is not conclusive.

> A patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men . . . .[14]

Indeed, critics of the Federal Circuit standard note that, in many fields, no one bothers to publish the obvious; in others, such as software or business methods, there may be no strongly established publication culture, or no long history of formal publications.[15] In yet others, practices may be adapted

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[12] *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

[13] *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976).

[14] *Sakraida* at 281, quoting *Great A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152 (1950) (ellipses in *Sakraida*).

[15] FTC Report, Chapter 4 at p. 40 (describing factors complicating the nonobviousness inquiry for business methods, including "the absence of a drive to publish within business method fields (unlike, for example, the sciences), and the fact that commercial practices in question often only exist in the 'heads of business person.'"); Chapter 5 at p. 7 (noting tes-

from a different context, a phenomenon particularly common in the shift of retailing from bricks-and-mortar to the Internet.

The Federal Circuit's test says, in essence, that all doubtful cases, all cases in the gray area, will be decided in favor of patentability. In other words, it has decided to run zero risk of rejecting a meritorious claim even at the cost of accepting numerous non-meritorious patents.

This is not sensible doctrine. Nor is it in accord with the statutory language or the precedents of this Court.

It also has the pernicious effect of preventing the USPTO and even Congress (unless it amends the "obviousness" standard itself, which would have major ramifications) from adopting administrative remedies that would reduce errors of *both* kinds. Re-examinations, reviews, post-grant challenges, and other devices are under active consideration. But under the Federal Circuit standard, none of these would allow PTO to reject any patent for obviousness unless it could find a document suggesting the solution.

The defects of such a doctrine may well be illustrated by the notorious Patent 6,368,227, "Method of Swinging on a Swing,"[16] obtained by a five-year old whose parent happened to be a patent lawyer. It is also called the "sideways swinging" patent, because that is what it covers—the idea that a swing can be made to move sideways as well as back and forth by pulling on the chains in a particular way.

The Patent Commissioner ordered a re-examination of the '227 patent on May 21, 2002,[17] and ultimately PTO found

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timony that prior art problems are particularly hard to discover "in fields characterized by limited or abstract patent disclosures or lacking a culture favoring non-patent publication.")

[16] United States Patent No. 6,368,227, Method of Swinging on a Swing. Filed Nov. 17, 2000; Granted April 9, 2002. (Steven Olson)

[17] USPTO, Official Gazette Notices, July 2, 2002,

sufficient prior art in patents granted in 1939, 1943, and 1969 to result in its invalidation.[18] But the case ought never to have gotten so far; scarce patent-examiner hours and public resources had to be expended to officially recognize the obvious.[19] The difficulty the office faced resulted from the fact that the Federal Circuit's standard forbade the examiners to take notice of what, literally, any child would know. As a newspaper report on the matter said, "The patent office is searching for documented proof that children have always powered their swings by pulling on the chains. Then, and only then, will it kill the patent as quietly as possible."[20]

Had USPTO been unable to find *written* proof of something known to all, then under the Federal Circuit test the patent would have stood. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'"[21] "'Common knowledge and common sense,' even if assumed

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[18] Reexamination Certificate (4803rd), Method of Swinging on a Swing. Issued July 1, 2003.

[19] On reexamination, USPTO found three relevant prior patents, including one granted in 1939 on a device that boasted an ability to enable "various motions and movements of the seat, such as horizontal, circular, whirling, gyratory, oval, and oscillating, thereby creating much more amusement and pleasure than is obtained by the ordinary lawn swing." United States Patent No.2,146,045, Amusement Swing, Filed July 2, 1936; Granted Feb. 7, 1939 (S. W. Zippler), cited in Reexamination Certificate (4803rd), Method of Swinging on a Swing. Issued July 1, 2003. The strong implication is that the desirability of such motions, and presumably their attainability on a conventional two-ropes-on-a-tree-limb swing, were well-known prior to 1939.

[20] David Streitfeld, "Note: This Headline is Patented," *Chicago Tribune* (Online Edition), Feb. 7, 2003 (unpaginated) <http://www.chicagotribune.com/technology/local/chi-0302,0,7319176.story>.

[21] *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001).

to derive from the agency's expertise, do not substitute for authority when the law requires authority."[22]

In the swing patent case, ultimately, the PTO reached the sensible result. But the Federal Circuit decisions present an obstacle to the office's doing so in a significant number of cases. For example, in 1999, the Federal Circuit reversed the PTO's rejection of a patent application for orange trash bags with jack-o-lantern faces.[23] A prior art search had turned up instructions for a children's craft project involving the drawing of pumpkin faces on large orange bags. But this was not sufficient, because the instructions referred to paper bags, not to trash bags.

The Federal Circuit's motivation in this case and others is a dread of "the insidious effect of a hindsight syndrome;"[24] the court is concerned that there must be objective evidence of obviousness. Such concern is certainly legitimate, but "objective" surely need not mean that instructions for the claimed invention must always be set out in some writing. There are other ways to avoid the problem of unduly subjective tests and hindsight, such as a "second look" by other patent examiners, review boards, and by giving patent examiners better access to experts qualified as to testify as to the capabilities of someone skilled in the art in question.

The Federal Circuit's one-way ratchet in favor of patentability will have deleterious effects on the whole innovation system. Entrepreneurs will devote their efforts not to solving problems but to putting together new combinations of old elements in the hopes that some one of them will turn out to be a future barrier to someone who is trying to solve a

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[22] *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002).

[23] *In re Dembiczak*, 175 F. 3d 994 (Fed. Cir. 1999).

[24] *Id.* at 999.

problem, and thus a turnstile into which cash payments must be inserted. The term "tollkeepers" is used.

Another metaphor heard in conversations about the issue is that entrepreneurs are scattering patents like landmines, hoping that every once in a while the genuine innovators will step on one. Such actions are a misdirection of technical resources, and a barrier to desirable innovation. They also greatly increase the transaction costs of the system without any compensating incentives for creativity.

Yet another form of harm from an overly-generous interpretation of the nonobvious standard is more subtle: Over-patenting undermines the basic justifications for the patent system, and encourages those, and they are many, who would eliminate or hamstring the system of property rights in intellectual creations. As noted earlier, PFF is a fierce defender of these rights—it supports the content industries in *Grokster* [25]—and it is precisely this perspective that leads us to emphasize that these rights must be appropriately defined and limited.

Concern for maintaining the legitimacy of the system is particularly acute in the context of international affairs. Some in the less-developed world see the patent system, and intellectual property generally, as a mechanism by which the developed world extracts tribute from them.[26] To the extent

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[25] *Brief of* Amicus Curiae *Progress and Freedom Foundation in Support of Petitioner*, Metro-Goldwyn-Mayer Studios v. Grokster, Ltd., *cert. granted*, __U.S.__ (2004) (No. 04-480) (Brief filed: Jan. 24, 2005).

[26] *See, e.g., Statement by India at the Inter-Sessional Intergovernmental Meeting on a Development Agenda for WIPO*, April 11-13, 2005, available at http://weblog.ipcentral.info/archives/2005/04/more_wipo_india.html ("Given the huge asymmetry between developed countries and developing countries, the total absence of any mandatory cross-border resource transfers or welfare payments, and the absence of any significant domestic recycling of the monopoly profits of foreign IP rights holders, the case for strong IP protection in developing countries is without any

that the system nurtures technological innovation that is then shared with the less-developed nations, and to the extent that the system helps them develop IP industries of their own, such a view is ludicrous. But if the U.S. patent system agrees to assertions of dominion over inventions that are not worthy innovations, and that would indeed by found quickly by experts in other parts of the world, this charge attains real bite.

IV. Solutions are Possible

As the Petition requests, this Court should reinvigorate its line of cases stemming from *Graham v. Deere*. But it can also look further back for guidance. There are historical antecedents for the current dilemma, and precedents for its resolution, during the late 19th century, as described by railroad historian Steven W. Usselman.[27] Then, as now, explosive technological, financial, and institutional change created a climate of creativity. Then, as now, complaints of overreaching and fears of gridlock abounded. Then, as now, the concept of "obviousness" was a puzzle—what was truly new and what was within the grasp of anyone skilled in the art, only some grasped it a little more quickly than others?

These issues were bitterly fought for years, and this Court came down on the side of common sense, in *Atlantic Works v. Brady*, per Mr. Justice Bradley:

> The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-workmen and engineers is generally ade-

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economic basis. Harmonization of IP laws across countries is, clearly, intended to serve the interests of rent seekers in developed countries rather than that of the public in developing countries.")

[27] Steven W. Usselman, *Regulating Railroad Innovation: Business, Technology, and Politics in America, 1840-1920*, pp. 143-176 (Cambridge Univ. Press 2002).

quate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each forward step prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in consequences.

The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. *It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts.* It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith. [Emphasis added.][28]

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[28] *Atlantic Works v. Brady*, 107 U.S. 192, 199-200 (1882). It should be noted that the enactment of section 103 of the Patent Act in 1952, which codified an "obviousness" standard for the first time, is sometimes taken to have been intended to reverse the older, more stringent judicial standards of "obviousness." *See, e.g.* Irah H. Donner, *Combatting Obviousness Rejections Under 35 U.S.C. Section 103*, 6 Alb. L.J. Sci. & Tech. 159, 163 (1996). But it was unlikely that it was intended to uproot all of the old judicial doctrines entirely, particularly since the statute did not expressly repudiate them and indeed recognizes the legitimate need for

The effective application of the limitation that innovations are patentable only if they are nonobvious is vital to the effectiveness of the patent system in fulfilling its constitutional function of "promot[ing] the Progress of Science and useful Arts." The goal is to create incentives for inventors to solve problems (hence the utility requirement) in new ways, not to reward them for successfully gaming the system, for "watch[ing] the advancing wave of improvement, and gather[ing] its foam in the form of patented monopolies," in Mr. Justice Bradley's phrase.

To the extent that an invention is "the foam" on the "advancing wave," and within the probable ken of any skilled artisan who addresses a problem, the grant of a patent is not necessary to foster the discovery. It will, by definition, be found when the problem which it solves becomes important enough to engage serious attention. And there is no reason for the system to encourage investment in innovations that develop solutions that may or may not be needed in the future. If the problem is *not* sufficiently pressing to engage the present attention of those skilled in the art, then it shouldn't be the subject of inventive resources.

Nor, in such cases, is a patent necessary to fulfill another important function of the system: to encourage disclosure of a technology that would otherwise remain secret. Nothing that is "foam" on the "advancing wave" will remain secret for long.

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something more than a mechanical inquiry into prior art. There is no need for the Court to restore the pre-1952 case law requiring a flash of inventive genius for a patent's validity to be upheld in order to recognize that the Federal Circuit has gone much too far in the other direction.

V. This Case Presents a Good Vehicle for Reinvigorating the Nonobviousness Criterion

This case is a particularly attractive vehicle for this Court to use in addressing this serious need for a proper delineation of nonobviousness. While the principle is of particular importance in the growing high tech areas, such as software and biotech, it is extremely difficult for laypersons to grasp the issues in such cases.

Consequently, an explication of obviousness in such a context would be a difficult pedagogical exercise, and would be unlikely to produce a result that could be easily extrapolated to other areas.

On the other hand, every schoolchild knows what an accelerator pedal is. Therefore, this case provides an ideal context for the discussion of the principles involved. Those who are expert in more arcane technologies will then be able to extrapolate the application of the principles to those situations, whereas an explanation wrapped up in the details of software or biotech would be very difficult to reverse engineer back to its application to mechanical devices.

CONCLUSION

For the above-stated reasons, the Court should accept this case for review.

Respectfully submitted,

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